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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,266	05/10/2001	Shunpei Yamazaki	12732-035001 / US4908	5445
26171	7590	12/29/2003	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			EHICHOYA, FRED I	
			ART UNIT	PAPER NUMBER
			2172	

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/852,266	Applicant(s)	YAMAZAKI ET AL.
Examiner	Fred I. Ehichioya	Art Unit	2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1 – 25 and 27 - 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) 26 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5 and 8.
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1 – 54 are pending in this office action.
2. The examiner accepts the drawings filed on May 10, 2001.

***Claim Objections***

3. Claim 26 is objected to because of the following informalities: Claim 26 is missing from the pre-amended sheet.

In the pre-amendment, page 1, applicants stated “amend claims 1 – 25 as follows.” and on page 11, stated “claims 1 – 26 have been amended as follows.” but there is no pre-amended claim 26 as stated. However, claim 26 is unchanged according to page 45 as submitted on 5/10/2001.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 20, 23, 25 – 36, 43 – 45, and 49 - 54 are rejected under 35 U.S.C 102(e) as been anticipated by UK Patent Application GB 2 348 309 A issues to Kaoru Uchida (hereinafter “Uchida”).

Regarding claims 1, 7, 11 and 17, Uchida teaches a communication system for distinguishing a user, said system comprising:

a storing means for storing reference living body information (see page 20, lines 13 – 17; Uchida discloses “fingerprint” as “living body”);

a reading means for reading collation living body information of the user (see page 21, lines 17 – 19);

a collating means for collating the collation living body information with the reference living body information (see page 22, lines 1 – 9; Uchida discloses “checking unit 12” as “collating means”); and

a sending means for sending a notice of coincidence as data to a mating party when a collation result proves coincident (see page 11, lines 8 – 15 and page 29, lines 15 – 23),

wherein a communication between the user and a mating party is started through the manager after the mating party receives the notice of coincidence as data (see page 23, lines 5 – 10); Uchida discloses “authenticating executing device 2” as “mating party”).

wherein a password is sent as data to the mating party/manager after the notice of collation is sent to the mating party/manager, and the reference living body

information is rewritten when the password is authenticated as correct on the mating party (see page 1, lines 23 – 25).

Regarding claims 2 and 12, Uchida teaches a wherein the reference living body information comprises n reference living body information, the collation living body information of the user comprises n collation living body information of the user, the collating means collates the n collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when all of collation results prove coincident (see page 8, lines 15 – 24).

Regarding claims 3 and 13, Uchida teaches wherein the reference living body information comprises n reference living body information, the collation living body information of the user comprises in collation living body information of the user, the collating means collates the m collation living body information with the n reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of the n reference living body information coincides with at least one of the m collation living body information (see page 21, lines 14 – 27).

Regarding claims 4 and 14, Uchida teaches wherein the reference living body information comprises a plurality of kinds of reference living body information, the collation living body information of the user comprises a plurality of kinds of collation

living body information of the user, the collating means collates the plurality of collation living body information with the plurality of reference living body information, and the sending means sends the notice of coincidence as data to the mating party when the plurality of kinds of collation living body information wholly coincide with the plurality of kinds of reference living body information (see page 29, lines 4 – 23, page 30, lines 19 – 27 and page 31, lines 1 – 29).

Regarding claims 5 and 15, Uchida teaches wherein the reference living body information comprises  $n$  reference living body information of a plurality of kinds, the collation living body information comprises in collation living body information of a plurality of kinds of a user, the collating means collates the  $m$  collation living body information with the  $n$  reference living body information, and the sending means sends the notice of coincidence as data to the mating party when at least one of each kind of collation living body information among the plurality of kinds of collation living body information coincides with at least one of each kind of reference living body information among the  $n$  reference living body information (see page 23, lines 5 – 23).

Regarding claims 6 and 16, Uchida teaches wherein the reference living body information comprises  $n$  reference living body information of a plurality of kinds, the collation living body information comprises  $m$  collation living body information of a plurality of kinds of a user, the collating means collates the  $n$  collation living body information with the  $n$  reference living body information, and the sending means sends

the notice of coincidence as data to the mating party when all of the plurality of kinds of collation living body information coincide with all of the n reference living body information (see page 21, lines 14 – 27).

Regarding claims 8 and 9, Uchida teaches a causing means for causing the manager to send the notice of coincidence as data to a mating party (see page 24, lines 7 – 21 and page 29, lines 13 – 23),

wherein the communication between the user and the mating party is directly started after the mating party receives the notice of coincidence as data (see page 27, lines 21 - 27).

Regarding claims 10 and 27, Uchida teaches wherein a transaction is conducted between the user and the mating party (see page 1, lines 7 – 14),

wherein an identification of the user is requested only when the condition set to the mating party is satisfied (see page 28, lines 10 – 15).

Regarding claims 18, 28, 29 and 30, Uchida teaches wherein the reference living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 19, 31, 32 and 33, Uchida teaches wherein the collation living body information comprises at least one selected from the group consisting of a fingerprint, a palm print and a voiceprint (see page 35, lines 7 – 16).

Regarding claims 20, 26, 34, 35, 36, 52, 53 and 54, Uchida teaches wherein the palm print is a palm print of the whole palm or a palm print of a part of the palm (see page 35, lines 7 – 16).

Regarding claims 23, 43, 44 and 45, Uchida teaches a portable information terminal is used (see page 35, lines 17 – 22).

Regarding claims 25, 49, 50 and 51, Uchida teaches a personal computer is used (see page 1, lines 16 – 22).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 24, 37 – 42, and 46 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida in view of USPN 6,219,793 issued to Yang Li et al (hereinafter “Li”).

Regarding claims 21, 37, 38 and 39, Uchida discloses the claimed subject matter as discussed in 1,7, 11 and 17 respectively. Uchida does not explicitly teach the storing means is a flash memory.

Li teaches the storing means is a flash memory (column 12, lines 20 – 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Li with the teaching of Uchida wherein the memory storage means is a flash memory. The motivation is that flash memory is capable of storing image data.

Regarding claims 22, 40, 41 and 42, Uchida discloses the claimed subject matter as discussed in 1,7, 11 and 17 respectively. Uchida does not explicitly teach the reading means is a photodiode or a charge coupled device.

Li teaches the reading means is a photodiode or a charge coupled device (see column 4, lines 50 – 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Li with the teaching of Uchida wherein the reading means is a photodiode. The motivation is that photodiode can be read and transmitted in electronic form.

Regarding claims 24, 46, 47 and 48, Li teaches a cellular telephone is used (see column 4, lines 33 – 49).

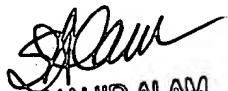
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-303-3900.

Fred I. Ehichioya  
Art Unit 2172  
December 28, 2003



SHAHID ALAM  
PRIMARY EXAMINER